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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,432	06/26/2001	Linlee Blake Nelson	P0113	5171

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EXAMINER

CRONIN, STEPHEN K

ART UNIT PAPER NUMBER

3727

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,432

Applicant(s)

NELSON, LINLEE BLAKE

Examiner

Stephen K. Cronin

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02072005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2005 has been entered.

Response to Amendment

2. The declaration under 37 CFR 1.132 filed February 7, 2005 is insufficient to overcome the rejection of claims 1-7 and 9-21 based upon 35 USC 103(a) as set forth in the last Office action because:

The evidence fails to present facts which are germane to the rejection at issue. The evidence presented is also not commensurate in scope with the claims. Applicant merely provides a time line and sales figures of an invention sold under the trademark RV SHOE BUDDY without addressing the structure of the invention sold, how this structure compares to the structure set forth in the claims and how this structure compares to the prior art.

It include(s) statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 and 9-21 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The declaration under 37 CFR 1.132 by Linlee Nelson dated February 2, 2005 and filed February 7, 2005 states in paragraph number 2 that in January of 1997 that the disclosed and claimed invention was offered for sale to Ron Reid a representative of Camping World. The declaration further states in paragraph

number 3 that in April of 1997 Mr. Reid indicated that he would place an order for the invention. The declaration further states in paragraph number 6 that on June 16, 1997 Ron Reid placed an initial purchase order for the said invention. All three of these events represent an offer for sale and a sale of the disclosed and claimed invention more than one year prior to the filing of applicants provisional application 60/099,453 on September 8, 1998 to which applicant claims priority.

5. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: Applicant must fully explain the circumstances surrounding numbered paragraphs 1-7 set forth in the declaration under 37 CFR 1.132 by Linlee Nelson filed February 7, 2005. See in particular MPEP 2133.03 and the case law set forth below:

Public use" of a claimed invention under 35 U.S.C. 102(b) occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor." *In re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). The presence or absence of a confidentiality agreement is not itself determinative of the public use issue, but is one factor to be considered along with the time, place, and circumstances of the use which show the amount of control the inventor retained over the invention. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986). See *Ex parte C*, 27 USPQ2d 1492, 1499 (Bd. Pat. App. & Inter. 1992) (Inventor sold inventive soybean seeds to growers who contracted and were paid to plant the seeds to increase stock for later sale. The commercial nature of the use of the seed coupled with the "on-sale" aspects of the contract and apparent lack of confidentiality requirements rose to the level of a "public use" bar.); *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881) (Public use found where inventor allowed another to use inventive corset insert, though hidden from view during use, because he did not impose an obligation of secrecy or restrictions on its use.).

As the degree of commercial exploitation surrounding 35 U.S.C. 102(b) activity increases, the burden on an applicant to establish clear and convincing evidence of experimental activity with respect to a public use becomes more difficult. Where the examiner has found a *prima facie* case of a sale or an offer to sell, this burden will rarely

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be met unless clear and convincing necessity for the experimentation is established by the applicant. This does not mean, of course, that there are no circumstances which would permit alleged experimental activity in an atmosphere of commercial exploitation. In certain circumstances, even a sale may be necessary to legitimately advance the experimental development of an invention if the primary purpose of the sale is experimental. *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979); *Robbins Co. v. Lawrence Mfg. Co.*, 482 F.2d 426, 433, 178 USPQ 577, 582 (9th Cir. 1973). However, careful scrutiny by the examiner of the objective factual circumstances surrounding such a sale is essential. See *Ushakoff v. United States*, 327 F.2d 669, 140 USPQ 341 (Ct.Cl. 1964); *Cloud v. Standard Packaging Corp.*, 376 F.2d 384, 153 USPQ 317 (7th Cir. 1967).

As discussed in MPEP § 2133.03, a policy consideration in questions of 35 U.S.C. 102(b) activity is premature "commercial exploitation" of a "completed" or "ready for patenting" invention (see MPEP § 2133.03(c)). The extent of commercial activity which constitutes 35 U.S.C. 102(b) "on sale" status depends upon the circumstances of the activity, the basic indicator being the subjective intent of the inventor as manifested through objective evidence. The following activities should be used by the examiner as indicia of this subjective intent:

(A) Preparation of various contemporaneous "commercial" documents, e.g., orders, invoices, receipts, delivery schedules, etc.;

(B) Preparation of price lists (*Akron Brass Co. v. Elkhart Brass Mfg. Co.*, 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir. 1965) and distribution of price quotations (*Amphenol Corp. v. General Time Corp.*, 158 USPQ 113, 117 (7th Cir. 1968));

(C) Display of samples to prospective customers (*Cataphote Corp. v. DeSoto Chemical Coatings, Inc.*, 356 F.2d 24, 27, 148 USPQ 527, 529 (9th Cir. 1966) *mod. on other grounds*, 358 F.2d 732, 149 USPQ 159 (9th Cir.), *cert. denied*, 385 U.S. 832 (1966); *Chicopee Mfg. Corp. v. Columbus Fiber Mills Co.*, 165 F.Supp. 307, 323-325, 118 USPQ 53, 65-67 (M.D.Ga. 1958));

(D) Demonstration of models or prototypes (*General Elec. Co. v. United States*, 206 USPQ 260, 266-67 (Ct. Cl. 1979); *Red Cross Mfg. v. Toro Sales Co.*, 525 F.2d 1135, 1140, 188 USPQ 241, 244-45 (7th Cir. 1975); *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 815-16, 131 USPQ 413, 429-30 (D.Del. 1961)), especially at trade conventions (*InterRoyal Corp. v. Simmons Co.*, 204 USPQ 562, 563-65 (S.D. N.Y. 1979)), and even though no orders are actually obtained (*Monogram Mfg. v. F. & H. Mfg.*, 144 F.2d 412, 62 USPQ 409, 412 (9th Cir. 1944));

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(E) Use of an invention where an admission fee is charged (*In re Josserand*, 188 F.2d 486, 491, 89 USPQ 371, 376 (CCPA 1951); *Greenewalt v. Stanley*, 54 F.2d 195, 12 USPQ 122 (3d Cir. 1931)); and

(F) Advertising in publicity releases, brochures, and various periodicals (*In re Theis*, 610 F.2d 786, 792 n.6, 204 USPQ 188, 193 n. 6 (CCPA 1979); *InterRoyal Corp. v. Simmons Co.*, 204 USPQ 562, 564-66 (S.D.N.Y.1979); *Akron Brass, Inc. v. Elkhart Brass Mfg., Inc.*, 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir.1965); *Tucker Aluminum Prods. v. Grossman*, 312 F.2d 393, 394, 136 USPQ 244, 245 (9th Cir. 1963)).

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1–6, 10-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salley 1,727,485 in view of Wilson 3,181,751.

Salley teaches an auto pocket article carrier comprising a planar mounting surface 8, a back panel 2, a front panel forming a plurality of storage compartments 3 and a securing mechanism 7, 22. See also the specification at lines 40-58. Salley however does not teach that the pockets may be formed with an increasing cross-sectional area from their bottoms to their tops. Wilson teaches a similar carrier formed from a back panel and a front panel which forms a plurality of pockets in which the pockets are sewn onto the back panel in a manner in which the cross-sectional area of the pockets increases from their bottoms to their tops. See figure 2. Wilson also teaches that pockets sewn to a

rear panel may also form more than one row. To form the pockets of Salley in the manner as taught by Wilson to obtain a plurality of rows of pockets with increasing cross-sectional areas would have been obvious to one of ordinary skill in the art to obtain the benefits inherent in the design of Wilson since both inventions teach alternative ways in which pockets may be sewn onto a rear panel.

8. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salley 1,727,485 in view of Wilson 3,181,751 as applied to claims 1-6, 8, 10-16 and 18-20 above, and further in view of Harnish 5,345,633.

To use an alternative equivalent means for attaching a carrier to a mounting surface such as the hook and loop fasteners taught by Harnish in place of the fastening system taught by Salley would have been an obvious substitution of equivalent means for fastening.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salley 1,727,485 in view of Wilson 3,181,751 as applied to claims 1-6, 8, 10-16 and 18-20 above, and further in view of Cirigliano 5,653,337.

To vary the height of the pockets of Salley in the manner as taught by Cirigliano to allow the storage and easier retrieval of different size objects would have been obvious to one of ordinary skill in the art.

Response to Arguments

10. Applicant's arguments filed February 7, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that "the cited references do not suggest the shoe storage device of the subject invention", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The prior art is capable of performing the claimed intended use.

In response to applicant's argument that "A person of ordinary skill in the art would never be motivated to modify the framed carrier of Salley with the fishing tackle bag of Wilson, the carpenters tote of Cirigliano, and the headrest of Harnish" in order to arrive at applicants claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The prior art of Salley teaches the basic structure, concept, function and intended use of applicants claimed invention. The prior art of Wilson, Cirigliano and Harnish were relied upon for a clear teaching that the structural features claimed by applicant that differ from the structure of Salley is old and well known in the art and are obvious variations to the structure of Salley.

In response to applicant's argument that applicants claimed device fits along the pedestal of a queen-sized bed in an RV and the compartments are configured to hold large bulky items and the prior art as combined would not meet these limitations, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It is further noted that the features which applicant argues above are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the


application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen K. Cronin whose telephone number is 571-272-4536. The examiner can normally be reached on M-F 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 571-272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen K. Cronin
Primary Examiner
Art Unit 3727

skc